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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/051,938	01/17/2002	Eugene R. Zehler	M 5850A-OS/LUAP	3048

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COGNIS CORPORATION
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EXAMINER

KING, BRADLEY T

ART UNIT	PAPER NUMBER
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3683

DATE MAILED: 05/08/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/051,938

Applicant(s)

Zehler

Examiner

Bradley King

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jan 17, 2002
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 38-84 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 53, 79, and 80 is/are allowed.
- 6) ☒ Claim(s) 38-44, 46-52, 54-60, 62-74, 76-78, and 81-84 is/are rejected.
- 7) ☒ Claim(s) 45, 61, and 75 is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

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DETAILED ACTION

Specification

1. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: claims require a mixture of monocarboxylic and dicarboxylic acids. The specification fails to provide antecedent basis for this feature.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 46-51, 62-66, and 76 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 46-51, 62-66, and 76 (added in the amendment on 1/17/02) have limitations requiring a mixture of monocarboxylic acid and dicarboxylic which are not supported by the disclosure and are held as new matter.

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Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 38-44, 52, 54-60, 67-74, 77-78, and 81-84 are rejected under 35 U.S.C. 103(a) as being unpatentable over Duncan et al in view of Funkhouser.

Duncan et al disclose biodegradable lubricants and further discloses a variety of applications including hydraulic fluids (see column 1, lines 30-33). The composition in table 8 (TPE/C810/Ck8) includes pentaerythritol with straight chained carboxylic acid component having 6-12 carbon atoms and a biodegradability of 92.9%. Funkhouser discloses all the features of the shock absorber including a cylinder 20 containing a fluid, a piston rod 26, a piston, first and second chambers and means for permitting fluid communication being disposed in at least a portion of the piston. Funkhouser remains silent as to the composition of the fluid within the absorber. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the fluid disclosed by Duncan et al with a shock absorber as

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taught by Funkhouser as an obvious implementation of the fluid which addresses environmental concerns with regards to leaking shock absorbers.

Regarding claims 40, 56, 70, 78, 82 and 84, Duncan et al disclose blends of trimethylolpropane with over 80% biodegradability in table 8.

Regarding claims 41, 57 and 71 Duncan et al suggest mono or dicarboxylic acids for linear acids and monocarboxylic acid for the branched acids.

Regarding claims 43, 59 and 73, the above mentioned composition contains branched C8 acids.

Regarding claims 44, 60, and 74 Duncan et al disclose the use of a mixture of linear acids in the above cited composition (column 20, lines 44-54).

Regarding claims 52, and 67, see column 13, lines 26-45.

Allowable Subject Matter

6. Claim 45, 51, 61, and 75 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.


7. Claims 53, and 79-80 are allowed.

Conclusion

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8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Schlosberg et al, Schnur, Bongardt et al, Walker, Carr et al, Burrous Warman, Kleiman et al, and Davis.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bradley King whose telephone number is (703) 308-8346.


JACK LAVINDER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600
5/6/02

BTK

May 5, 2002